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NO. 211465/00491

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant(s): Banerjee et al.	)
	)
Application No.: 09/909,248	)
	)
Filed: July 19, 2001	)
	)
For: Structure and Method for Controlling a Host Computer	)
Using a Remote Hand-Held Interface Device	)
	)
Group Art Unit: 2672	)
	)
Examiner: Brier, Jeffery A.	)
	)
Customer No.: 27160	
Confirmation No.: 9312	

CERTIFICATION OF TRANSMISSION

I hereby that this correspondence is bein; facsimile transmitted ((571) 273-8300) to th United States Patent and Trademark Office on

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Date

Mary Kay Dau
Signature

Mary Kay Durr

Printed Name of Person Signing
Certificate

APPLICANTS' BRIEF ON APPEAL

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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I. REAL PARTY IN INTEREST

The real party in interest is NEC Corporation, Tokyo, Japan by virtue of an Assignment from the Inventors to Zenith Data Systems Corporation, recorded on Reel/Frame 007134/0215, a merger of Packard Bell NEC into NEC Corporation recorded on Reel/Frame 009149/0324 and 010592/0695 and an assignment from Packard Bell NEC , Inc to NEC Corporation..

II. RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to the Appellants or the Appellants' representative, which are believed to directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

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III. STATUS OF CLAIMS

Claims 1, 6 and 7 are pending. The final rejection of claims 1, 6 and 7 forms the basis for this appeal. These claims 1, 6 and 7 have been rejected under 35 U.S.C. §103(a) as being unpatentable over McCain U.S. patent no. 5,309,351.

IV. STATUS OF AMENDMENTS

An amendment filed subsequent to the final rejection pursuant to MPEP §1207 has been entered and indicated in an Advisory Action to overcome the objection to claim 1.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The present invention relates to a mobile user interface device that is adapted to interface with a remote host computer 101 having a wireless interface 115.
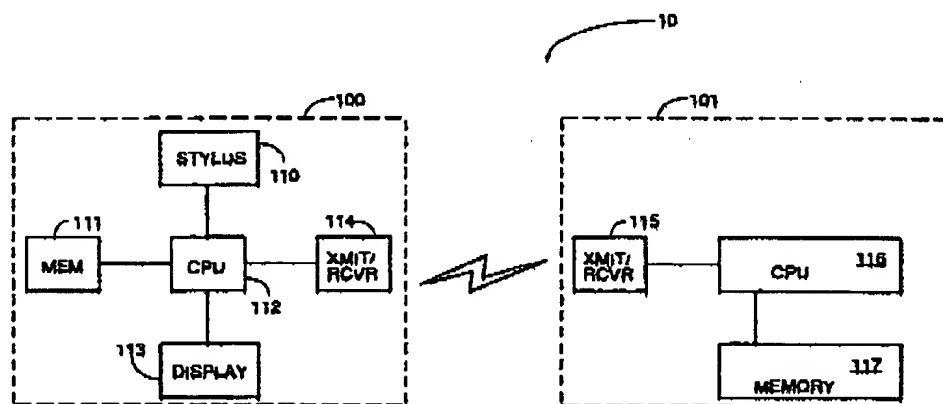

FIG. 1a

The system includes a controller as illustrated in FIG. 1b below, which allows the interface device 100 to control the execution on the host computer 101.
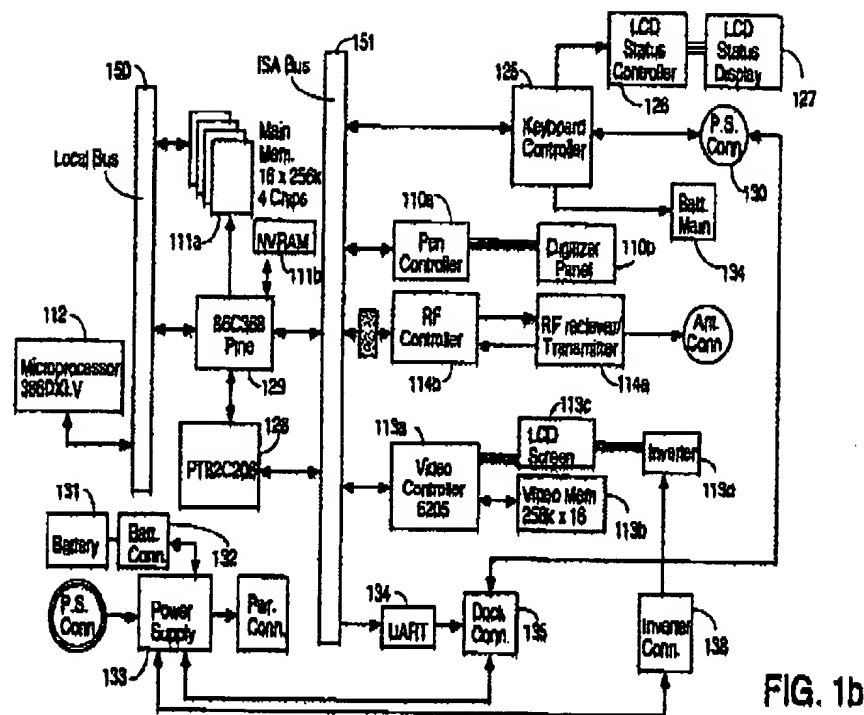
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FIG. 1b

The interface device 101 includes a central processing unit (CPU) 112, a local memory sub-system 111, a stylus or pen-based input sub-system 110, an LCD sub-system 113, and a communication sub-system 114. As set forth in the specification at page 7, line 35, "the controller of (the interface) need not be a general purpose microprocessor, or even a microprocessor. Such a controller can be a logic circuit implemented, for example, by an application-specific integrated circuit.

Claims 1 and 6 are independent claims. Each of these claims recite a controller (Fig. 1b) which has a mouse mode and a pen mode for "*emulating the movement of a mouse and the clicking of a mouse button in said mouse mode and means for translating pen events in a pen mode and means for switching between a pen mode and a mouse mode*". More particularly, claims 1 and 6 recite an interface device 100(Fig. 1A) which includes a controller 112 implemented as a CPU (Fig. 1b and Page 7, lines 34-35).

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Claim 1 recites an interface device 100 includes an input subsystem 110 (Page 8, lines 25-31; page 11, line 23 to page 12, line 8) ; a graphical display subsystem 113 (Page 7, line 31; page 8, lines 14-20; and page 12, lines 9-25) and a wireless communication system 115 (Page 9, lines 31-33; page 12, line 26 to page 13, line 2). The controller 112 controls the graphical display system 113; the input subsystem 110; and the wireless communication system 115; and causes (i) wireless communication to be created (Page 12, lines 26-28); (ii) an application program to be run on the host computer (Page 6, line 23 to Page 7, line 5) ; (iii) receiving from said input subsystem said positional data, providing a response to said user in acknowledgement of said positional data, and transmitting over said wireless communication link from said application program data representing said image, and causing said graphical display subsystem to display said image on said graphical display (Page 6, lines 17-25), said input subsystem having a pen mode and a mouse mode and including means for monitoring pen down events of said passive stylus and emulating the movement of a mouse and the clicking of a mouse button in said mouse mode and means for translating pen events in a pen mode and means for switching between a pen mode and a mouse mode (Page 20, lines 20-35). Claim 6 has elements that are essentially similar to claim 1 and additionally recites a remote host computer 101 (Fig. 1a) ; means for monitoring pen down events of a passive stylus and emulating the movement of a mouse and the clicking of a mouse button in said mouse mode mode (Page 20, lines 20-35); means for translating pen events in a pen mode (Page 8, line 25 to page 9, line 10) and means for switching between a pen mode and a mouse mode (Page 11, line 35 to Page 12, line 8). Claim 6 also recites means for modifying said image (Page 11, line 23 to page 12, line 8).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Claims 1, 6 and 7 as being unpatentable over McCain et al US patent no. 5,309,351.

GROUPING OF CLAIMS

It is respectfully submitted that claims stand or fall together.

VII. ARGUMENTS

1. **REJECTION OF CLAIMS 1,6 and 7 UNDER 35 U.S.C. §103(A) AS BEING UNPATENTABLE OVER McCain et al**

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Claims 1, 6 and 7 as being unpatentable over McCain et al US patent no. 5,309,351. As mentioned above, claims 1, 6, and 7 recite, in combination, a mobile user interface device "interface" for controlling a remote host computer. All of the claims recite that the interface includes "a controller having a pen-mode and a mouse-mode" which includes "means for monitoring pen-down events of" (a) passive stylus and emulating the movement of a mouse and the clicking of a mouse button in (a) mouse mode and means for translating pen events in a mouse mode and means for switching between a pen mode and mouse mode." It is respectfully submitted that the McCain, et al. patent does not teach or disclose such a configuration. FIG. 7 of the McCain, et al. patent illustrates the operating modes of the hand-held interface device disclosed therein. The various operating modes of the hand-held unit are also described in detail in the McCain, et al. specification, column 9, line 15 et seq. Nowhere does the McCain, et al. patent disclose or suggest a system which can perform the same functionality as the device recited in the claims at issue. For example, the McCain, et al. patent does not disclose a system for *emulating the movement of a mouse and the clicking of a mouse button.*

It is respectfully submitted that is appears that the examiner is actually rejecting the claims based on information in the specification and not on the claims themselves. More particularly, the rejection of the claims is based on 35 U.S.C. § 103(a) based on the McCain, et al. patent. However, the examiner's response to the Applicant's arguments, as set forth in paragraph 3 of the Detailed Action, mailed on April 23, 2004, implies that the claims have been rejected because of information the Examiner has extracted from the specification ("Thus, the claims need to be amended to claim applicants invention of having a view manager 200 located in the handheld device anticipate pen mode events and anticipate mouse mode events while Pen Windows 310 located in the host computer makes the final determination and if the anticipation was incorrect then the view manager 200 must correct any anticipated inking or mouse mode with the host determine inking or mouse mode ... Since claim 6 does not claim where the controller is located and since the controller is actually located in both the hand-held device and the host computer then the rejected based on McCain and Pen Windows is maintained").

On one hand, it is respectfully submitted that the Examiner is rejecting the claims based upon 35 U.S.C. § 103(a) as being unpatentable over the McCain, et al. patent while asserting that additional information from the specification needs to be incorporated into the claims. However, the examiner has failed to address the issue that the claims, as currently amended, recite various

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features that are clearly not disclosed or suggested in the McCain, et al. patent. For example, the claims all recite a system which emulates, *inter alia*, a system for emulating a mouse mode, and particularly, ***emulating the movement of a mouse and the clicking of a mouse button.*** Nowhere does the McCain, et al. patent disclose or suggest a system for emulating the movement of and clicking of a mouse. For these reasons, it is respectfully requested that the rejection of claims 1, 6, and 7 be reversed.

Moreover, it is respectfully submitted that the Examiner has failed to make out a *prima facie* case of obviousness. In particular, as set forth in MPEP, §2143 in order to establish a *prima facie* case of obviousness, three basic criteria must be met:

> "First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined must teach or suggest all of the claimed limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the Applicants' disclosure."

As mentioned above, it is respectfully submitted that the Examiner has failed to show that the McCain et al patent suggests or discloses all of the claimed limitations. Accordingly, for all of the above reasons, it is respectfully submitted that based , the rejection does not make out a *prima facie* case of obviousness. For these reasons and all of the above reasons, the Board is respectfully requested to reverse the Examiner's rejection of claims 1, 6 and 7.
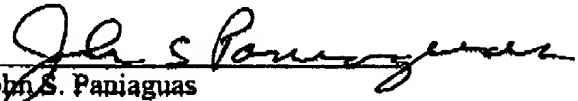
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CONCLUSION

The Board is respectfully requested to reverse the rejection of the claims by the Examiner.

Respectfully submitted,

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CLAIMS APPENDIX

1. (Rejected) A mobile user interface device for interfacing with a remote host computer having a wireless interface, comprising:

a graphical display subsystem including a digitizer responsive to a passive stylus graphical display for displaying an image;

an input subsystem including a stylus for receiving from a user, positional data representing spatial positions of said stylus;

a wireless communication subsystem for establishing a wireless communications link directly with said remote host computer for sending data to and receiving data from said remote host computer over a wireless communication link; and

a controller for controlling operations of said graphical display subsystem, said input subsystem and said wireless communication subsystem, said controller (i) causing said wireless communication to be created; (ii) causing an application program to be run on said remote host computer; (iii) receiving from said input subsystem said positional data, providing a response to said user in acknowledgement of said positional data, and transmitting over said wireless communication link from said application program data representing said image, and causing said graphical display subsystem to display said image on said graphical display, said input subsystem having a pen mode and a mouse mode and including means for monitoring pen down events of said passive stylus and emulating the movement of a mouse and the clicking of a mouse button in said mouse mode and means for translating pen events in a pen mode and means for switching between a pen mode and a mouse mode.

6 (Rejected): A computer system comprising:

a hand-held interface device comprising (i) a display device; (ii) an input device; (iii) a wireless receiver and transmitter circuit for transmitting data from said input device to an application program running on a remote host computer and receiving a response to said data from said application program running on said remote host computer; and (iv) a controller for

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providing an image on said display device said controller being operable in a pen mode and a mouse mode and including means for monitoring pen down events of a passive stylus and emulating the movement of a mouse and the clicking of a mouse button in said mouse mode mode and means for translating pen events in a pen mode and means for switching between a pen mode and a mouse mode; and

a remote host computer having a wireless receiver and transmitter circuit for communication with said hand held interface; and means for modifying said image.

7 (Rejected): A computer system as recited in claim 6, wherein said wireless receiver and transmitter circuit is configured to be accessed by said remote host computer as a shared resource on a local area network.

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EVIDENCE APPENDIX

None

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RELATED PROCEEDINGS APPENDIX

None